

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANNY L. MILLER

Appeal No. 98-1451
Application No. 08/529,187¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge,
STAAB and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 17 and 19, which are all of the claims pending in this application.

We REVERSE and REMAND.

¹ Application for patent filed September 15, 1995.

BACKGROUND

The appellant's invention relates to an armature assembly support pallet. An understanding of the invention can be derived from a reading of exemplary claims 1, 15 and 17, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wilger et al. (Wilger)	3,830,488	Aug. 20, 1974
Egigian	5,529,371	June 25, 1996
		(filed April 14, 1995)

Claims 1 through 17 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wilger in view of Egigian.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 15, mailed October 27, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellant's

Appeal No. 98-1451
Application No. 08/529,187

Page 3

brief (Paper No. 12, filed July 7, 1997) for the appellant's
arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness² with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 17 and 19 under 35 U.S.C. § 103. Our reasoning for this determination follows.

We now turn to the examiner's rejection of claims 1 through 17 and 19.

Wilger discloses a propeller manipulating and work stand. As shown in Figure 1, the propeller manipulating and work

² In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

stand 10 includes a base 12, a post 14, an A-frame 30, bearings 24 and 40, a tubular bearing 20 and a saddle 36. As shown in Figures 4-6, a mandrel shaft 6 and propeller 8 can be accommodated in the tubular bearing 20 and the saddle 36 of the stand 10.

Egigian discloses a rail saver pad. As shown in Figures 1-2, a protective pad 10 is disposed on the top of the rails 14-16 of a pick-up truck 10. Thereafter, a camper shell 12 can be mounted thereon with the pad maintaining a good water seal. As shown in Figure 3, the pad 100 includes a strip 105 of magnetic material to hold the pad on the rails 14-16.

The examiner found (answer, pp. 3-4) that Wilger "discloses the claimed invention except for the magnetic material attached to the support member." Thereafter the examiner determined (answer, p. 4) that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Wilger et al. support device to include a magnetic material as taught by Egigian for the purpose of joining two components magnetically to prevent their relative movement to each other.

The appellant argues (brief, pp. 8-13) that (1) there is no suggestion in the applied prior art to modify Wilger in the manner proposed by the examiner, and (2) Egigian is non-analogous art. We agree.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. In fact, the advantages of utilizing a magnetic support surface as set forth in the claims under appeal are not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the limitation regarding the magnetic support surface as set forth in the claims under appeal is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection.

In addition, we find that Egigian is non-analogous art. The test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). First, we agree with the appellant (brief, p. 8) that Egigian is clearly not within the field of the inventor's endeavor, i.e., armature assembly support pallets. Second, we agree with the appellant (brief, pp. 8-10) that Egigian is not reasonably pertinent to the problem with which the inventor was involved, i.e., the need to maintain an armature assembly carried by a support pallet in a uniform axial position while on the support pallet. Thus, we conclude that Egigian is non-analogous art.

For the reasons set forth above, the decision of the examiner to reject claims 1 through 17 and 19 under 35 U.S.C. § 103 is reversed.

Remand for Appropriate Search

This application is remanded to the examiner for consideration of a further search of the claimed subject matter.

The claimed subject matter is directed to an armature assembly support pallet (claims 1-16) and a support assembly for use in an armature assembly support pallet (claims 17 and 19). However, the disclosure (specification, p. 1) sets forth that this invention relates to an armature assembly support pallet used for conveying a partly constructed electric motor armature assembly during manufacture. Thus, a search should be considered in Class 198, Conveyors: Power-Driven. Specifically, subclasses 803.5 and 867.04 appear to be pertinent to the claimed subject matter.

Accordingly, we remand this application to the examiner to consider a search of Class 198 and any other pertinent field of search.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 17 and 19 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner to consider a further search.

REVERSED; REMANDED

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge
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LAWRENCE J. STAAB)
Administrative Patent Judge)

JEFFREY V. NASE)
Administrative Patent Judge)

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Appeal No. 98-1451
Application No. 08/529,187

Page 11

JVN/gjh

Appeal No. 98-1451
Application No. 08/529,187

Page 12

ROGER S. DYBVIG
22 GREEN STREET
DAYTON, OH 45402

APPEAL NO. 98-1451 - JUDGE NASE
APPLICATION NO. 08/529,187

APJ NASE

APJ STAAB

SAPJ McCANDLISH

DECISION: **REVERSED; REMANDED**

Prepared By: Gloria Henderson

DRAFT TYPED: 25 Jan 99

FINAL TYPED: